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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/021,341	12/12/2001	Yongcai Wang	82662HEC	6168

7590 07/28/2004
Patent Legal Staff
Eastman Kodak Company
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Rochester, NY 14650-2201

EXAMINER

SCHWARTZ, PAMELA R

ART UNIT	PAPER NUMBER
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1774

DATE MAILED: 07/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/021,341

Applicant(s)

WANG ET AL.

Examiner

Pamela R. Schwartz

Art Unit

1774

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 May 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 4-16 is/are pending in the application.
- 4a) Of the above claim(s) 1 and 4-15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1 and 4-16 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

1. Amended claims 1 and 4-15 directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1 and 4-15, drawn to an imaged recording element, classified in class 428, subclass 195.
- II. Claim 16, drawn to a recording element for receiving ink jet recording ink, classified in class 428, subclass 32.25.

The inventions are distinct, each from the other because of the following reasons:

Inventions of Group II and of Group I are related as mutually exclusive species in an intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product (MPEP § 806.04(b), 3rd paragraph), and the species are patentably distinct (MPEP § 806.04(h)). In the instant case, the intermediate product is deemed to be useful as a paper for printing with an ink pen, typewriter or pencil and the inventions are deemed patentably distinct since there is nothing on this record to show them to be obvious variants. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions anticipated by the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 1 and 4-15 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

2. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kitamura et al. (EP 903,246) for reasons of record (as set forth in the prior rejection under 35 USC 102) and for reasons given below. First, the fact that applicants have provided thicknesses for the two layers does not overcome the fact that there is no claimed difference in composition and that applicants' "two layers" are equivalent to a single layer of the same composition.

Additionally, those of ordinary skill in this art have adopted the term ink-receiving layer or image-receiving layer to refer to one or more receptive layers. This was actually done in the reference that states that the ink receiving layer may have a multilayered structure (see page 7, last line).

With respect to the phrase "consists essentially for preventing light fade of...", the language "consists essentially of" is normally used to limit the composition of what follows rather than the function. It is unclear that a material can be limited to a specific function since materials are normally capable of performing multiple functions. A

reference would not be overcome if applicable compositionally merely because a different usage is ascribed to it.

However, even if applicants modified usage of "consisting essentially of" is proper, Kitamura et al. still applies. Applicants' specification states that UV absorbers may be used to prevent fade as well as antioxidants (page 17 of the specification) and UV absorbers are conventional additives to one of more layers of an ink jet recording material. Therefore, it is unclear how inclusion of UV absorbers could be considered to materially affect the basic and novel characteristic(s) of the claimed invention, an ink jet recording element.

3. Applicant's arguments filed May 17, 2004 have been fully considered but they are not persuasive. A terminal disclaimer was filed and has been accepted to overcome the obviousness type double patenting rejection. Applicants state that the light fade test on page 22 supports their means plus function language. However, the examiner did not find any teaching at that location to support the means plus function language. Instead, the examiner believes the language at page 17, line 3 best supports and defines the means plus function language of the claim, i.e. UV absorbers, radical quenchers, or antioxidants. Applicants argue that their base layer is not image receiving, but rather "an additional sump for absorption of the solvent for the ink." Since the composition of the layers may be the same, the name attributed to the layers is not relevant. Applicants use the term image-receiving for their upper layer, and state in their response on page 6 that the purpose of their base layer is "to act as an additional sump for absorption of the solvent for the ink." The reference uses the term ink receiving

rather than image receiving. Therefore it does not recite two image receiving layers as suggested by applicants. Its lower ink-receiving layer may serve as a sump for the ink solvent which is an ink-receiving function. The lower layer receives a portion of the ink and is consistent with applicants' base layer. This terminology cannot be used persuasively to distinguish applicants' invention from the prior art.

Applicants also attempt to rely on differences in composition between their two layers which are set forth in their examples but are not claimed. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., differences in composition between the base layer and the image receiving layer) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicants also argue that it would not have been obvious to include stabilizer particles in a base layer. The examiner disagrees. Since many of these materials tend to migrate in the recording element over time, one of ordinary skill in the art would expect inclusion of antioxidant or other light fade prevention means in the adjacent base layer to enhance overall light fade. The examiner disagrees that applicants' use of "consisting essentially" successfully excludes UV absorbers. The basic and novel characteristic of the invention is its usefulness as an ink jet recording element. Inclusion of UV absorber will not materially affect this. While the examiner disagrees with applicants' conclusion that UV absorbers are not equivalents to antioxidants in

accordance with the specification for purposes of their means plus function language, this is irrelevant in the phrase "consists essentially for preventing light fade of..." which does not include the means plus function language or draw antecedent basis therefrom.

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pamela Schwartz whose telephone number is (571) 272-1528.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye, can be reached on (571) 272-3186. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PRSchwartz
July 26, 2004



PAMELA F. SCHWARTZ
PRIMARY EXAMINER